

Appln No. 10/799,143
Amdt date October 3, 2008
Reply to Office action of April 3, 2008

REMARKS/ARGUMENTS

Claims 1-2, 5-8, 21-22, 25-27 and 29-32 are pending in the application for examination, of which claims 9-15 and 28 have been withdrawn.

Claims 1-2, 7-8, 21-22 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent DE 298 10 798. Claims 5 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent DE 298 10 798 in view of Harms et al., and claims 6 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent DE 298 10 798 in view of Hall. Applicants respectfully traverse the rejection.

On pages 2-3 of the Office action, the Examiner states that DE '798 discloses a "first internal thread extending from the exterior end surface of the receiving part to a second distance that is smaller than or equal to the pre-determined distance (A)." Applicant respectfully disagrees.

DE '798 only shows the left side of the anchoring element, the right side of the anchoring element is not shown and therefore no conclusion can be drawn whether the right hand thread extends to a position beneath the outer surface of the rod. In addition, the Examiner's position is contradicted by the teachings of Farris et al. (6,485,491), DE 101 57 969, and Mehdian (5,217,497) (all of which are of record in this application). In each case, the threads on the right side of the receiving part extend lower than the threads on the left side of the receiving part. In view of the above, applicant respectfully submits that claims 1, 2, 5-8, 21, 22 and 25-27 are not anticipated by DE '798.

On pages 6-7 of the Office action, claims 29 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent DE 298 10 798. The Examiner states that it would have been an obvious matter of design choice to construct the first thread comprising fewer than four full turns, since such modification would have involved a mere change in the size of the component, i.e., the threaded area. Applicant respectfully traverses the rejection.

Applicant's invention does not simply change the size of a component. Changing the size of the DE '798 anchoring element would involve making the entire element larger or smaller,

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including the threads. The number of threads, however, would remain the same. Applicant's invention does not simply reduce the size of the DE '798 anchoring element, but includes the additional steps of reducing the size of the legs while employing the same size thread and reducing the number of threads in total. The benefit of this, taught by the present application, is that a shorter anchoring element may be used during spinal surgery. Applicant respectfully submits that the teaching of a receiving part having fewer than four full turns as recited in claims 29 and 30-32 based on DE '798 is the result of improper hindsight reconstruction based on the applicant's own disclosure.

In view of the above, Applicant respectfully requests reconsideration of the application and the allowance of claims 1-2, 5-15, 21-22, 25-28 and 29-32.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By Mark Garscia
Mark Garscia
Reg. No. 31,953
626/795-9900

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